

the ground that the claims allegedly recapture subject matter surrendered in the prosecution of the original application. Both these rejections are respectfully, but vigorously, traversed. It is assumed that the Examiner intended to allow the claims but his informed decision was overruled.

***The Rejection Based on an Allegedly Defective Reissue Declaration is Erroneous***

The Examiner, for the first time in the prosecution of this application, asserted that the Reissue Declaration is defective on the asserted ground that "If new claims are presented, their differences from the original claims must be pointed out." Having made that assertion, the Examiner rejected Claims 6-38 under 35 U.S.C. § 251 and 37 CFR 1.175.

It is respectfully pointed out that neither 35 U.S.C. § 251 nor 37 CFR 1.175 makes such a requirement. In fact, § 1.175 was amended on October 10, 1997 (62 Fed. Reg. 53196 (1997)) to remove what might be interpreted as making such a requirement (compare 37 CFR § 1.175(a)(1-7) (1977) with 37 CFR § 1.175(a)(1-2) (1978)).

According to the MPEP, aside from the requirement that the Reissue Declaration comply with 37 CFR 1.63(b), there are only three basic requirements which must be fulfilled:

1. A statement that "Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing" and/or a statement that

"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent" (MPEP § 1414, ¶ I, p. 1400-16); and

2. A statement of at least one error which is relied upon to support the reissue application (MPEP § 1414, ¶ II, p. 1400-16); and

3. A statement that "All errors which are being corrected in the present reissue application up to the time of filing of this declaration arose without any deceptive intention on the part of the applicant" (MPEP § 1414, ¶ III, p. 1400-17).

Every one of these requirements is met by the instant Reissue Declaration (see the Supplemental Reissue Declaration, the paragraph on page 1 starting with "I verily believe ..." through page 2, second full paragraph). It is noted, incidentally, that this part of the Supplemental Reissue Declaration was taken *verbatim* from the PTO form Reissue Declaration which was used as the original Reissue Declaration. It must be presumed that the PTO form complies with the Statute and the Rules of Practice. Consequently, this rejection borders on the frivolous.

The Examiner is, therefore, respectfully requested to withdraw this rejection.

***The Rejection Under 35 U.S.C. § 251 as Being an Improper  
Recapture of Broadened Claimed Subject Matter Surrendered in  
the Original Application is in Error***

The Examiner again rejected the claims (in the first Action, the Examiner rejected Claims 11-30 on this ground, but in this Action, he rejected Claims 11-31, 35, and 36) under 35 U.S.C. § 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner asserted that the "broadening aspect" in the reissue relates to subject matter previously surrendered during the prosecution of the original application. Specifically, the examiner said, "Claims in the instant application must include all the structure from the original claims in [grandparent application Serial No.] 08/371,210 to avoid recapture." While the Examiner did not elucidate, it is assumed that he was referring to the "ring supporting surface" of the housing which does not appear in the rejected claims.

The points made in the Reply filed November 9, 2000, are clear, succinct, and correct. They are repeated here in their entirety.

Original Claim 3 of the grandparent application read:

The device of claim 2, wherein said housing has a ring supporting surface, said end portions of the housing and the cap having such axial dimensions that a play is retained between their mutually facing surfaces when said ring abuts said engaging

portion of the cap and the peripheral portion of said ring abuts said supporting surface.

Thus, Claim 3 essentially had two limitations:

1. said housing has a ring supporting surface; and
2. said end portions of the housing and the cap having such axial dimensions that a play is retained between their mutually facing surfaces when ....

In the Office Action of June 2, 1995, the Examiner rejected Claims 1, 2, and 4 under 35 U.S.C. § 102(b) as anticipated by a reference (U.S. Patent No. 3,815,787) to Spies. The Examiner explained:

Spies shows a device for emptying a tube (14) comprising a ring (50), housing (16), a piston (40), cap (64), dispensing opening (92), annular engaging portion (70) and supporting surface (24). [Emphasis added.]

At the same time, the Examiner indicated the allowability of Claim 3.

As the Examiner correctly pointed out in the Action, recapture occurs when an applicant attempts to obtain in a reissue claims which were cancelled or otherwise relinquished during prosecution of the original patent. It is clear from the case law that an applicant may not omit a limitation which was relied upon for patentability. See e.g., *Hester Industries Inc. v. Stein Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984); and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

It is clear that it was limitation 2 which was relied upon for patentability and not limitation 1. In the Office Action of June 2, 1995, the same Examiner said that the prior art Spies reference teaches a "supporting surface (24)". Thus, that limitation was not relied upon for patentability and may, under the prevailing case law, be omitted.

At the interview of August 25, 2000, the Examiner agreed and in telephone conversations on January 3 and January 23, 2001, the Examiner confirmed that he was allowing all the claims. Nevertheless, in this Action, he maintained the rejection which, it is again submitted, is erroneous. This rejection is a misuse of the judicially created doctrine of "recapture". The Examiner is, therefore, respectfully requested to withdraw this rejection.

Since all the claims are clearly in condition for allowance and are free of the prior art, an early Notice of Allowance is in order and the same is most earnestly solicited. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated.

Respectfully submitted,



Herbert I. Cantor  
Registration No. 24,392

CROWELL & MORING LLP  
P.O. Box 14300  
Washington, D.C. 20044-4300  
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Tel. 202-628-8800  
Fax 202-628-8844